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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/198,067	11/28/1998	MICHAEL PRINCE	1400.9800940	2061

25697 7590 09/10/2002

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EXAMINER

NGUYEN, STEVEN H D

ART UNIT

PAPER NUMBER

2665

DATE MAILED: 09/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/198,067

Applicant(s)

PRINCE ET AL.

Examiner

Steven HD Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-13 and 17-21 is/are rejected.
- 7) ☒ Claim(s) 2-4,11,12,14-16,20 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 5-9, 13 and 17-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Katou (USP 6347088).

Regarding claims 1, 9, 13 and 18, Katou discloses (Fig 1-21 and col. 1, lines 10 to col. 11, lines 54) an adaptive service interworking (Fig 17) comprising the steps of in response to receive a setup message for identifying a receiving party which is coupled to the endpoint switch from a sending party, obtaining connection information of an end point network switch (Fig 16, Ref 52 receiving a setup message and query the database “Fig 17, Ref 1702” to obtaining the connection information of the endpoint switch 501 which support a transparent link between the 501 endpoint switch or node); interpreting the connection information to determine whether the

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endpoint switch is capable of supporting a transparent link between the sending and receiving party (Fig 16, Ref b and Fig 6-8 wherein the call setup message is judged by interworking unit for determining if the end point switch supporting a transparent link the calling party or called party) and when the endpoint switch supports the transparent link, supporting the transparent link between the receiving and sending party (Fig 16, Ref c and Fig 2003; see col. 11, lines 15-54).

Regarding claims 5-6, Katou discloses the connection information comprising at least one of a data transport protocol and a network switch type (Fig 17, Ref 1702 and Fig 18 are a database which stores a network switch type for supporting transparent link and ATM protocol) wherein the network switch type can be used to process the enhanced traffic description (Fig 3, traffic description).

Regarding claim 7, Katou discloses the receiving party is a user (Fig 13, operator).

Regarding claims 8 and 17, Katou discloses the service interworking being default to translation if the endpoint network does not support transparent link (Fig 7).

3. Claims 9-10 and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Amri (USP 5535199).

Regarding claims 9-10 and 18-19, Amri discloses a method for adaptive service interworking comprising the steps for receiving a setup message that identifies a receiving (Fig 6a, Ref B, the remote station receives a call setup for establishing a data transport protocol using RFC 1144), interpreting the setup message to determine whether a transparent link is to be established between a sending party by extracting an enhanced traffic descriptor which identifies the data transport protocol from the setup message to determine if the receiving party supports the data transport protocol of sending party and receiving party when the transparent link is to be

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established, supporting a transparent link (See col. 7, lines 43 to col. 8, lines 30, the remote station extract the PID from the setup message to determine if the remote station supports the data transport protocol RFC 1144 or not, if yes, a transparent link between the receiving and sending party).

Allowable Subject Matter

4. Claims 2-4, 11-12, 14-16 and 20-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

5. Applicant's arguments with respect to claims 1-8 and 13-17 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument at page 4 that Amri is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Amri discloses a method and apparatus for established a transparent link between the users as disclosed at col. 7, lines 30 to col. 8, lines 30).

In response to applicant's argument at page 4 that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a

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link between the sending and receiving ... transport protocol) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven HD Nguyen whose telephone number is (703) 308-8848. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D Vu can be reached on (703) 308-6602. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.



Steven HD Nguyen
Primary Examiner
Art Unit 2665
September 8, 2002